

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-8 are now present in this application. Claims 1, 2, 7 and 8 are independent.

By this Amendment, an amendment has been made to the specification and claims 1-2 and 4 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Personal Interview

Applicant acknowledges the courtesies extended by Examiners Saxena and Shah to their representative, Robert. J. Webster, Reg. No. 46,472, during the personal interview conducted on June 23, 2010. During that interview, all of the outstanding objections and rejections of record were discussed as well as possible claim amendments. Applicant's representative provided Examiner Saxena with a four page article, discussed below, and Examiner Shah provided Applicants' representative with a legible copy of the Wright reference, of record, and certain claim language amendments were discussed. No agreement regarding patentability was reached.

Specification Objection

The Examiner has objected to the specification because of several alleged informalities. In order to overcome this objection, Applicants have further amended the paragraph bridging pages 3 and 4 along lines discussed during the interview. With respect to the meaning of "the entity file of an OS (operating system)," Applicant's representative obtained a four page article, on his own initiative without input from the Applicant, and in an attempt to present information to the Examiner during the personal interview conducted on June 23, 2010 concerning the objections to the specification in the outstanding Office Action, gave Examiner Saxena a copy of that four page article, which is available at www.cadfamily.com/downinfo/293604.html, and which discusses file system improvements for a computer program entitled, "CADFamily." Applicants' representative believed at the time that the article discusses and explains entity files

for a CAD program with respect to windows Vista operating system. Applicants' representative has been subsequently requested to present a copy of JP 08-335181 (and a computer generated English language translation of its specification) to the Examiner, which references the term "entity file" and refers to it as being known to one of ordinary skill in the art and provides the following for the Examiner's consideration. The term "entity file" means content of date itself and the meaning of "entity file" has a clear and definite meaning to one of ordinary skill in the art, as evidenced by JP 08-335181, a copy of which is attached hereto.

Applicant also respectfully submits that the term "entity file of an OS" (in paragraph [0056] of the published application), i.e., an operating system (OS)'s entity file, is a file which is prepared on the operation system (OS). Applicant also respectfully submits that the use of the term "entity file" in paragraphs on page 17 of the Application, as filed, (in paragraphs [0061] of the published application) is done with respect to an entity file of CAD information, which differs from an "entity file of an OS" in paragraph [0056] of the published application.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-8 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The test for compliance with the second paragraph of 35 U.S.C. §112, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994), is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See also In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See also In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Moreover, this claim recites "substantially." Use of that term in a claim does not render the

claim indefinite if the specification provides a standard whereby one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. *See Seattle Box Co., Inc. v. Industrial Coating and packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-4 (Fed. Cir. 1984).

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *See In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

Applicants respectfully submit that the claims, as amended, fully comply with 35 U.S.C. §112, second paragraph as they stand and because one of ordinary skill in the art can readily determine the metes and bounds of the invention.

With respect to the language “performing management . . . other than that of the parameters set up . . .” this language has been canceled from claim 1, thereby mooted this ground of rejection.

With respect to the language “without data compatibility,” this language has been deleted and the objection has been mooted, accordingly.

Additionally, Applicants respectfully submit that the amended versions of claims 1, 2 and 4 fully comply with the requirements of 35 USC §112, second paragraph.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Claim Interpretations

With respect to claim 5, that claim did not contain the language “preparation means.” It does recite “preparation component,” but that is not “preparation means.” Accordingly, clarification of this interpretation is respectfully requested.

With respect to claim 4, this claim has been amended to clarify its meaning.

With respect to the meaning of “virtually shared state”, Applicants respectfully disagree with the meaning ascribed thereto on page 4 of the outstanding Office Action. The meaning of the language in issue is clear to one of ordinary skill in the art who realizes that a virtually shared state involves sharing design parameters using a plurality of different CAD systems.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 3, 5, 7 and 8 stand rejected under 35 USC § 102(b) as being anticipated by Wright et al. ("Wright"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). See *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. See *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in

the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1, as amended, recites a computerized design parameter managing method for managing design parameters used respectively in a two-dimensional CAD system and a three-dimensional CAD system, comprising: performing computerized separation of two-dimensional CAD data and three-dimensional CAD data used, respectively, which has been inputted in the two dimensional CAD system and the three-dimensional CAD system into geometrical information and attribute information; performing computerized setting up of arbitrary design parameters, by an inputting means for inputting a direction of a designer, independently among design parameters used respectively in the two-dimensional CAD system and the three-dimensional CAD system into shared design parameters and non-shared design parameters, and providing the shared design parameters in a virtually shared state among the two-dimensional CAD system and the three-dimensional CAD system; performing computerized correlation of the separated attribute information with the shared design parameters set up into the virtually shared state; preparing an attribute correlation table, which correlates attribute information of shared design parameters of the two-dimensional CAD system and the attribute information of the three-dimensional CAD system through design parameters, regarding to the attribute information which is correlating the design parameter with a virtually shared state in the two-dimensional CAD data and the three-dimensional CAD data; performing computerized accessing and recognizing of the separated attribute information correlated with the shared design parameters set up into the virtually shared state among two-dimensional CAD data and the three-dimensional CAD data used respectively in the two-dimensional CAD system and the three-dimensional CAD system; performing, in a co-design mode, computerized management of geometrical information of the shared design parameters set up into the virtually shared state which are correlated with the accessed and recognized separated attribute information as objects with data compatibility in the two-dimensional CAD system and the three-dimensional CAD system; separately and independently performing management of geometrical information of the non-shared design parameters which are not correlated with the accessed and recognized attribute information from the geometrical information which is performed

to manage as objects with data compatibility in the two-dimensional CAD system and the three-dimensional CAD system; retrieving existing attribute data in the attribute correlation table, recognizing geometrical information of the shared parameters correlated to the retrieved attribute data, and managing the geometrical information as an object of a cooperation design mode, wherein a relevancy between the geometrical information being an object of the attribute information and the attribute information is maintained separately; and performing bundling of the geometrical information of the two-dimensional CAD data in a virtually shared state and the geometrical information of the three-dimensional CAD data in a virtually shared state through design parameters based on the attribute correlation table, wherein three dimensional CAD data and two-dimensional CAD data are bundled for use in the two-dimensional CAD system and in the three-dimensional CAD systems; converting mutually the geometrical information between the two-dimensional space and the three-dimensional space and in order to interchange data between the two-dimensional CAD system and the three-dimensional CAD system which differ in geometrical dimensions in Euclidean space; and displaying information of the three-dimensional CAD data and information of the two-dimensional CAD data simultaneously on one display for use in development of a product.

Claim 2, as amended, recites a computerized design parameter managing system for managing design parameters used respectively in a two-dimensional CAD system and a three-dimensional CAD system, comprising: a computerized system component for separating two-dimensional CAD data and three-dimensional CAD data which has been inputted to the system, respectively, in the two-dimensional CAD system and the three-dimensional CAD system into geometrical information and attribute information; a computerized system component for setting up arbitrary design parameters, by an inputting means for inputting direction of a designer, independently among the design parameters used respectively in the two-dimensional CAD system and the three-dimensional CAD system into shared design parameters and non-shared design parameters, and for providing the shared design parameters in a virtually shared state among the two-dimensional CAD system and the three-dimensional CAD system; a computerized system component for correlating the separated attribute data with the shared design parameters set up into the virtually shared state; a computerized system component for preparing an attribute correlation

table, which correlates attribute information of shared design parameters of the two-dimensional CAD system and the attribute information of the three-dimensional CAD system through design parameters, regarding to the attribute information which is correlating the design parameter with a virtually shared state in the two-dimensional CAD system and the three-dimensional CAD system; a computerized system component for accessing and recognizing the separated attribute data correlated with the shared design parameters set up into the virtually shared state among the CAD data used respectively in the two-dimensional CAD system and the three-dimensional CAD system; a computerized system component for managing, in a co-design mode, geometrical information of the shared design parameters set up into the virtually shared state which are correlated with the accessed and recognized separated attribute data as objects with data compatibility in the two dimensional CAD system and the three-dimensional CAD system; a computerized system component for separately and independently managing geometrical information of the non-shared design parameters which are not correlated with the separated attribute information from the geometrical information as objects with data compatibility; a computerized system component for retrieving existing attribute data in the attribute correlation table, recognizing geometrical information of the shared parameters correlated to the retrieved attribute data, and managing the geometrical information as an object of a cooperation design mode, wherein a relevancy between the geometrical information being an object of the attribute information and the attribute information is maintained separately; a computerized system component for performing bundling of the geometrical information of the two-dimensional CAD data in a virtually shared state and the geometrical information of the three-dimensional CAD data in a virtually shared state through design parameters based on the attribute correlation table, wherein three dimensional CAD data and two-dimensional CAD data are bundled for use in the two-dimensional CAD system and in the three-dimensional CAD systems; a computerized system component for converting mutually the geometrical information between the two-dimensional space and the three-dimensional space and in order to interchange data between the two-dimensional CAD system and the three-dimensional CAD system which differ in geometrical dimensions in Euclidean space; and a display for displaying information of the three-dimensional CAD data and information of the two-dimensional CAD data simultaneously on one display for use in development of a product.

Applicants respectfully submit that Wright does not anticipate the subject matter of claims 1, 2, 3, 5 and 7.

The Examiner indicated during the interview that Fig. 3 of Wright shows no correlation between the Lid Outline design parameter in the lower left hand portion of Fig. 3, whereas all of the other design parameters shown in Fig. 3 are correlated, and that this is a disclosure of a non-shared design parameter being managed separately and not in the integrated MCAD and ECAD systems of Wright.

Applicants certainly did not understand this aspect of the rejection before the interview because the Fig. 3 of the copy of Wright reference furnished to Applicants by the USPTO is illegible, and because there was no explanation of why the lid outline was not treated as a shared design parameter.

Now that this aspect of the rejection has been clarified, Applicants respectfully traverse it for a number of reasons.

Firstly, nowhere does Wright explicitly disclose separating its disclosed design parameters, which include an enclosure, a lid, an enclosure top housing, an enclosure bottom housing, an enclosure depth, an enclosure top housing size, an enclosure bottom housing size, lid access holes for contact pads (and their size and position), a PCB outline and its size, a battery housing and its size, chips and chip heights, a capacitor and a capacitor, contact pads, and their size and position, and a lid outline, etc., into shared and non-shared parameters.

The Examiner stated during the interview, that Wright's Fig. 3 (which is disclosed as a component anatomy tree (CAT) that highlights cross-domain interactions or couplings between MCAD and ECAD design features), shows the Lid Outline design parameter (or feature) is not a shared parameter. This is nothing more than sheer speculation with no factual evidence in support thereof because Wright clearly advocates using expandable and collapsible CATs for complex products, which make it possible to view only a small subset of couplings between design parameters or features without confusion, which provides an explanation of why not all couplings are shown in Fig. 3. In other words, just because a coupling is not shown in Fig. 3 for the Lid Outline design feature, does not mean that one does not exist. Also, a design coupling for the Lid Outline may not exist, but that fact alone does not necessarily mean, or support a conclusion, that

Wright discloses separating the design parameters for a product (object) into shared and non shared parameters and treating only the shared parameters in a combined system and the non-shared parameters in a separate system. Actually, Wright only discloses a system that treats all design parameters without any concept of separating them into shared and non-shared parameters and treating only the shared parameters in an integrated design system.

Moreover, Applicants respectfully submit that, logically, the lid outline design parameter in Fig. 3 cannot be a non-shared parameter because if it were, it would not even be shown in Fig. 3, which presumably shows all parameters that are operated on by Wright's integrated MCAD and ECAD system.

The features of the subject invention are not only whether or not there are design parameters which are used independently. In Fig. 3 of Wright, "Lid Outline" seems to be used independently. However, there is no detailed description about constitutions of DUCADE in Wright. In the specification of the subject invention, it is described that the design parameters are separated into shared design parameter and non-shared parameter by a designer's direction, and then an attribute correlation table is prepared by using attribute information of the shared parameter.

Namely, the specification of the subject invention is described about the structure for preparing the attribute correlation table, clearly. However, Wright does not disclose features such as the above-mentioned features.

Furthermore, Wright does not disclose a number of other features which are positively recited in the amended claims.

For example, in the invention of this application, a designer may select arbitrarily design parameters (shared parameters) and/or the other parameters (non-shared parameters), and then the designer can set up them wherein these parameters are among those of two- and three-dimensional CAD systems, and the parameters are classified into the design parameters (shared parameters) which are set up into a virtually shared state and the other design parameters (non-shared parameters) which are not set up into the virtually shared state.

In case of design operation, the shared parameters are used in a cooperation design mode, while the non-shared parameters are not used in the cooperation design mode. Namely, the non-shared parameters are independently used, respectively for a design in respective design

processes of mechanism and exterior design processes, or electrical packaging design processes.

More specifically, in the invention of this application, respective CAD data of two- and three-dimensional CAD data are performed computerized separation into attribute information and geometrical information.

Then, an attribute correlated table is prepared for managing the attribute information among the above-described computerized separation of CAD data and the above-described shared parameters in a correlated state.

Geometrical information corresponding to the attribute information correlated to the shared parameters is extracted with respect to CAD data being an object to be performed computerization for a user in a two- or three-dimensional CAD system based on the above-described attribute correlated table, and then the geometrical information so extracted is managed as geometrical information of a target to be designed in cooperation mode.

In other words, the two- and three-dimensional CAD data are bundled through the shared parameters, and such geometrical information which is shared by the bundle is data-converted by means of a geometrical conversion converter.

As a result, even geometrical information of different dimensions becomes recognizable between the two- and three-dimensional CAD systems.

On the other hand, geometrical information corresponding to the attribute information which is not correlated with the shared parameters is discriminated from the geometrical information managed in a cooperation design mode, and the different geometrical information is independently edited only in each CAD system.

In Applicants' invention, a number of steps are conducted with respect to the two-dimensional CAD data of the two-dimensional CAD system and the three-dimensional CAD data of the three-dimensional CAD system. These performing steps are as follows:

- performing computerized separation of the respective CAD data into attribute information and geometrical information;
- performing computerized setting-up of design parameters which are to be in a virtually shared state (shared parameters) through the selection by a designer;
- performing computerized correlation of the shared parameters with the attribute

information;

- performing computerized management of the geometrical information corresponding to the attribute information correlated with the shared parameters in a cooperation design mode; and performing computerized conversion of the two-dimensional geometrical information managed in the cooperation design mode into three-dimensional geometrical information, and further converting the three-dimensional geometrical information managed in the cooperation design mode into two-dimensional geometrical information.

The Office Action's explanation of what Wright discloses does not address the combination of such features, i.e., of features present in claims 1 and 2, as amended.

In addition to sharing two-dimensional CAD data with three-dimensional CAD data and to correlate them with each other, in the invention of this application, design parameters are set up in such a manner such that they are in a virtually shared state or in a non-shared state, and data relating to the virtually shared state and data relating to the virtually non-shared state are separately handled, so that only a desired amount of data is collaboratively shared in two- and three-dimensional CAD systems design a product.

For example, a mechanical designer using a three-dimensional CAD system and an electrical equipment designer using a two-dimensional system can log on to Applicants' design parameter managing system using an ID managed by the system. The system is used to set up design parameters using functions involved in the system, whereby design parameters to be used by the mechanical designer or the electrical designer are separated independently into shared parameters and non-shared parameters. As a result, a design process proceeds in a co-design mode with respect to the shared parameters, while a design proceeds uniquely in the respective design processes in a mechanism exterior design process or an electrical packaging design process to complete the design with respect to the non-shared parameters.

Applicants' claimed invention permits more smooth exchange of mutual design concepts so that mutual design progress in a co-design mode can be directly monitored with respect to the design parameters shared by the two- and three- dimensional CAD systems, and further differential information in the design parameters shared between the two-and three- dimensional CAD systems is taken into consideration in the respective systems.

Furthermore, when electronic parts having a large number of design parameters to be shared in both a mechanism exterior design and an electrical packaging design are three-dimensionalized (converted into 3D data), and net information or pin information in an electrical packaging design, or physical properties of a material are placed into a library in a condition wherein design parameter attributes are applied, a system user can more precisely analyze the results in a mechanical exterior design.

The invention of this application eliminates such problem of “Poor flexibility in case of cooperation design arising from integration of all the design parameters in three- and two-dimensional CAD systems” which is a problem of a conventional management pattern.

More specifically, in the invention of this application, CAD data correlated with a virtually shared state and CAD data correlated with a virtually non-shared state are separately and independently managed respectively, whereby a highly flexible management system can be realized among a plurality of different CAD systems which have essentially different design targets.

Furthermore, according to the invention of this application, a design product having no shared relationship between three- and two-dimensional CAD systems can be designed independent of a design product having a shared relationship between three- and two-dimensional CAD systems, so that it becomes possible to conduct early design of such a design product having no shared relationship between three- and two-dimensional CAD systems.

Such technology as described above is realized by the invention of this application. As a result, such advantageous effects, which could have been not achieved by the prior art including the cited literature, that “it becomes possible to effect clearance verification specialized in electrical properties by reflecting the material information in the three-dimensional CAD data in the three-dimensional mechanism CAD system on the board data (two-dimensional CAD data) in the two-dimensional electric CAD system.” As described in the present specification.

The above-mentioned features and benefits are not described in, or derived from, Wright.

Accordingly, the Office Action does not make out a *prima facie* case of anticipation of claims 1-3, 5 and 7, and reconsideration and withdrawal of this rejection of claims 1-3, 5 and 7 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright. Claims 6 and 8 stand rejected under 35 USC §103(a) as being unpatentable over Wright in view of U.S. patent application Publication 2003/0001839 to Tatsuhiro. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital*

Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." See *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicants to come forward to rebut such a case.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the

legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988(Fed. Cir. 2006) (quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

In the sentence just prior to citing the *Kahn* case, the U.S. Supreme Court clearly stated that there has to be an apparent reason to combine the known elements in the manner claimed. The Office has the burden of making out a *prima facie* case of obviousness, i.e., by presenting objective factual evidence of a reason to combine the known elements in the manner claimed. The *KSR* decision did not lift that burden from the Office.

The articulated reasoning has to express a rationale explaining what would have led an ordinarily skilled artisan to combine selected features from each reference in a way that would have resulted in the claimed invention. See, *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, the Supreme Court reaffirmed the fundamental principles set forth in the *Graham v. John Deere Co.* decision, cited and discussed above.

For reasons presented above, Applicants respectfully submit that Wright fails to disclose the subject matter of claim 2, from which claims 4, 6 and 8 depend, that Tatsuhiro fails to remedy the shortcomings of Wright with respect to claim 2.

Accordingly, no matter how Wright is modified, neither Wright, nor Wright in view of Tatsuhiro can possibly render obvious the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 4, 6 and 8.

Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Application No.: 10/588,376
Art Unit 2128

Attorney Docket No. 1794-0187PUS1
Reply to Office Action dated April 15, 2010
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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 16, 2010

Respectfully submitted,

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PCL/RJW:kml

Attachments: JP 08-335181 (both Japanese language and computer generated English language Translation versions)

Importing CAD Files-Concepts, www.onlinehelp.agi32.com; August 3, 2010, pp. 1-8.